REMARKS

The Final Office Action, mailed November 8, 2005, considered and rejected claims 1-28 and 42-56. Claims 1 and 42 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the "invention". Claims 1-4, 8-13, 16, 17, 19-24, 26, 27, and 42-53 were rejected under 35 U.S.C. 103(a) as being unpatentable over Freund et al. (U.S. Publication No. 2003/0167405) and further in view of Goodman et al. (U.S. Patent No. 6,370,646). Claims 5-7, 14, 15, 18, 25, 28, 54 and 55 were rejected under 35 U.S.C. 103(a) as being unpatentable over Freund in view of Goodman and further in view of Lipe et al. (U.S. Patent No. 5, 748, 980). Claim 56 was rejected under 35 U.S.C. 103(a) as being unpatentable over Freund in view of Goodman and further in view of Parupudi et al. (U.S. Patent No. 6,750,883). [1]

By this paper, claims 1, 42 and 56 have been amended and new claims 57-59 have been added, such that claims 1-28 and 42-59 remain pending, of which claims 1 and 42 are the only independent claims at issue. [2]

The claims, as recited in claims 1 and 42, for example, are directed to embodiments for selecting characteristics associated with a network environment a computer system is being newly connected to, so as to reduce the configuration information that needs to be manually entered by a user. The recited embodiments include connecting a computer system, which is configured with a first configuration, to a network environment from among the number of network environments. Then, parameters are received from the new network environment, which are combined to generate an identifier. The identifier is then used to select characteristics specific to the network environment that the computer system is being connected to. Using these selected characteristics, which correspond specifically to the network environment that the computer system is being connected to, the configuration of the computer system is modified

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[1] Although the prior art status and some of the assertions made with regard to the cited art is not being challenged at this time, inasmuch as it is not necessary following the amendments and remarks made herein, which distinguish the claims from the art of record, Applicants reserve the right to challenge the prior art status and assertions made with regard to the cited art, as well as any official notice, which was taken in the last office action, at any appropriate time in the future, should the need arise, such as, for example in a subsequent amendment or during prosecution of a related application. Accordingly, Applicants' decision not to respond to any particular assertions or rejections in this paper should not be construed as Applicant acquiescing to said assertions or rejections.

[2] Support for the amendments and claim amendments is drawn from the previously presented claims, as well as the disclosure found in at least paragraphs 47 and 58-63.

from the first configuration to a new configuration. As further clarified by the claims, this modification or reconfiguration of the computer system includes reconfiguring at least one feature of the computer system other than a security feature.

With regard to the foregoing, Applicants respectfully submit that the recited claim language requiring 'reconfiguring at least one feature of the computer system other than a security feature' is not indefinite. Instead, it is merely broad enough to apply to any feature other than a security feature. Some examples of the features that are intended to fall within the scope of this claim language are even more particularly recited in the dependent claims. For example, the reconfiguration of features can correspond to such things as loading drivers with peripherals and unloading drivers for other peripherals (claim 45), ceasing a NIC connection and beginning a modem connection (claim 46), changing a favorites list (claim 47), causing the system to use a proxy or VPN (claims 22-23), causing the system to alter one or more country dependent software settings, such as a language or currency setting (claims 57-58), as well as modifying other features.

Next, with specific regard to dependent claims 56-58, which recite subject matter that was rejected at least in part on Parupudi, Applicants respectfully submit that Parupudi is an improper prior art reference for obviousness in the present case, inasmuch as Parupudi was assigned or subject to an assignment at the time of the invention to the assignee (Microsoft) of the present application, and inasmuch as Parupudi qualifies as prior art as 102(e) prior art (having issued in 2004, after the present application was filed in 2002).[3] Accordingly, inasmuch as Parupudi has been disqualified for use in an obviousness rejection, Applicants respectfully request that all of the rejections be withdrawn that are based on obviousness and that rely on Parupudi.

Now with regard to the substantive rejections, Applicants respectfully submit that the combination of Goodman and Freund, which is relied on for each rejection, should not be made. Applicants also submit that even if Goodman and Freund are combined that their combined teachings do not anticipate or make obvious the claimed invention[4].

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[3] See U.S.C. 103(e).
[4] Lipe was also relied on for some of the rejections to the dependent claims. However, inasmuch as Lipe was not used to reject the independent claims and inasmuch as it fails to compensate for the failings of the other cited art, the dependent claims should be allowed for at least the reasons described above with regard to the independent claims.

Initially, Applicants note that Freund generally deals with a client system recognizing a new network and thereafter determining whether to include or exclude the network from a trusted zone. The profile of the new network is also stored so as to later apply the same network security settings to the new network that were previously adopted. (Abstract, Summary)

Goodman, on the other hand, generally deals with embodiments for moving a computing system environment or setup from a source computer to a destination computer, such as, for example, when replacing a computer. Goodman facilitates the transfer of the existing system settings of the first computer to the new computer system.

In view of the teachings and general subject matter of Freund and Goodman, Applicants strongly disagree with the assertion made in the last office action that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Freund in view of Goodman in order to enable reconfiguring the features of a computer system other than security features…[and that] one would be motivated to do so in order to reduce man-hours and time involved in software migratory endeavors."

Initially, there would be no motivation to combine the teachings of Freund and Goodman because these references deal with completely different applications. Freund deals with identifying a new network and determining whether to apply previous security features to the newly connected network. Goodman, on the other hand, deals with transferring a system configuration from one computer to another.

As a final note on this matter, Applicants remind the Examiner that the although some of the elements of the claimed invention might be present in the cited art and although with significant and undue modification it might be possible to implements some of the claimed embodiments, Applicants respectfully remind the Examiner that simply because something is possible, does not make it obvious. In particular, in order to establish a *prima facie* case of obviousness, "the prior art reference (or references when combined) must teach or suggest all claim limitations." MPEP § 2143. The "FACT THAT THE CLAIMED INVENTION IS WITHIN THE CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT SUFFICIENT BY

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and such that it is not necessary to address the merits of the rejections or assertions made with regard to Lipe at this time. However, Applicants reserve the right to challenge the rejections and assertions made with regard to Lipe at any appropriate time in the future.

ITSELF TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS. A statement that modifications of the prior art to meet the claimed invention would have been "'well within the ordinary skill of the art at the time the claimed invention was made'" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references." MPEP 2143.01 (original emphasis). Furthermore, Applicants also point out that the motivation for making such a combination must come from the art itself; otherwise, such a combination represents impermissible hindsight. In particular, as stated by the MPEP § 2143, "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in application's disclosure." MPEP 2143. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

Applicants also submit that the asserted motivation for combining the references has not been established by the Examiner. In particular, Applicants question whether the combination of Freund and Goodman would actually reduce man-hours and time involved in software migratory endeavors. Accordingly, if the Examiner continues this line of reasoning, Applicants respectfully request that the Examiner provide documentation and rational showing how the combined teachings of Freund and Goodman would actually lead to a reduction in time during software migratory endeavors.

Nevertheless, Applicants respectfully submit that even if the teachings of Goodman and Freund are combined, they still fail to teach or suggest the claimed invention. For example, the Examiner has acknowledged that "Freund does not teach reconfiguring features of the computer system other than the security features." To compensate for this, the Examiner has relied on Goodman, by stating "Goodman teaches utilizing the selected characteristics to modify a configuration of the computer system..." Applicants strongly disagree.

In particular, with regard to "the selected characteristics", Applicants remind the Examiner that these "selected characteristics" are characteristics that are selected from an identifier generated by parameters associated with the computer system that are provided by the new network environment that the computer system is being connected with. Goodman never teaches or suggests the selection of any such characteristics corresponding to the newly connected environment. Instead, Goodman generally identifies characteristics of the existing

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software system of the computing system, which are defined by a script and that is used to generate genetic data to replicate the user settings in a new computer system.

Next, Goodman also fails to modify the configuration of the existing computing system to a new configuration. Instead, and to the contrary, Goodman is directed as preserving the same configuration during migratory endeavors. In fact, in this regard, Goodman actually teaches away from the asserted teachings of Freund and the present application.

Although the foregoing discussion has focused primarily on the independent claims, it will be appreciated that, for at least the foregoing reasons, all of the other rejections and assertions of record with respect to the independent and dependent claims are now moot, and therefore need not be addressed individually. However, in this regard, it should be appreciated that Applicants do not necessarily acquiesce to any assertions in the Office Action that are not specifically addressed above, and hereby reserve the right to challenge those assertions at any appropriate time in the future, should the need arise, including any official notice.

Applicants do note, however, that several of the rejections to the dependent claims do not appear to be adequately supported by the cited disclosure of the referenced art. Only two examples will now be provided, although others exist. Claim 46, for example, recites ceasing a NIC connection and beginning a modem connection. To reject this teaching, paragraphs 65 and 95 are cited in Freund. However, these paragraphs do not mention ceasing a NIC connection or beginning a modem connection. In fact, paragraph 95 doesn't mention either a NIC or a modem and paragraph 65 merely states that "The system communicates with other devices...via the network interface card (NIC) [] connected to a network... and/or modem. ..." This disclosure, however, even in combination with the disclosure in paragraph 95, fails to read on the claimed embodiment.

As a second example, claim 47 addresses an embodiment in which a favorites list is modified. To reject this claim, reference was drawn to Goodman Col. 7, ll 15-23. This disclosure, however, while addressing the types of scripts that can be used to migrate settings, including "desktop, network, printer and drive settings...preference settings, tool settings, customizations for dictionary or thesaurus, and document format settings", fails to address or suggest a favorites list. Furthermore, even if a favorites list could somehow be construed as a preference setting, there is nothing in this disclosure that suggests the modification of a favorites

list to correspond with a new network environment detected by a computing system. Instead, as mentioned above, Goodman generally suggests that settings are maintained and migrated to a new system, not changed in the manner claimed. Although the remaining dependent claims have not specifically been addressed herein, Applicants respectfully traverse the rejections to those claims for at least the foregoing reasons.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this ___14___ day of December, 2005.

Respectfully submitted,

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